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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,079	01/20/2000	David R. Montague	2779.2.2	3921

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EXAMINER	
DURAN, ARTHUR D	
ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/488,079	MONTAGUE, DAVID R.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2011*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *105-143* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *105-143* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/6/11*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 105-143 have been examined.

Response to Amendment

Examiner notes that on 12/31/2009 the BPAI fully affirmed the prior rejection of the claims in this case. Hence, the BPAI decision and the prior rejections were affirmed and are now part of the record on this case.

The new claims and amended claims filed on 1/20/11 is sufficient to overcome the prior rejection. However, please note the new rejection below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 105, 107, 110-143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Streich (3,314,592) in view of Blohm (5,881,538).

Claim 105, 107, 114, 124, 129, 136, 141. Streich discloses an apparatus comprising:

a product provided by the vendor (1:10-15; 1:10-25; 5:45-60);

a label comprising a face visible to a user at a point of purchase (1:10-15; 1:10-25; 5:45-60);

the label, further comprising a readable medium (1:10-15; 1:10-25; 5:45-60);

the label, wherein the readable medium further contains vendor data (1:10-15; 1:10-25; 5:45-60),

the label, further comprising information visible on the face and presenting an advertising impression, corresponding to at least one of the vendor and the product, to the user at the point of purchase (1:10-15; 1:10-25; 5:45-60);

a securement mechanism connecting the label to the product and configured to selectively secure to and release from the product and the label (1:10-15; 1:10-25; 5:45-60); and

the label, wherein the readable medium is operably independent from and the vendor information is substantively distinct from the product (1:10-15; 1:10-25; 5:45-60).

Streich further discloses a vendor (2:35-40) and that the customer buys the merchandise (3:35-45; 5:45-50). Also, note that the readable medium is operably independent from and the advertising information is substantively distinct from the product (5:45-60).

Streich does not explicitly disclose that the vendor is the advertiser. However, Streich discloses groceries as vendors and that the groceries advertise (2:35-45). Therefore, it is obvious that Streich's grocery can be a vendor/advertiser. One would be motivated to do this so groceries can better advertise/sell their items. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have

performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Streich does not explicitly disclose a network comprising a first computer, associated with a user and containing a first processor, operably connectable to a second computer, associated with a vendor and containing a second processor. However, Streich discloses stores with groceries (2:35-45). And, in May, 1999 it was common for stores or groceries to have websites. Hence, it is obvious that there can be a network linking a user and a vendor. Also, Examiner notes that this network is not actually used for anything in the current claim language. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Streich's groceries can have websites. One would have been motivated to do this in order to better assist groceries in presenting information. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Streich does not explicitly disclose data provided from the second computer by the vendor, and computer readable instructions executable on the first computer for presenting vendor information to the user. That is, Streich does not explicitly disclose that the label as a medium in Streich is a computer readable medium such as a CD or CD-ROM. However, the MPEP states that automating a manual activity is obvious

(MPEP 2144.04.III). Hence, while Streich discloses a wide range of ad mediums (5:45-60) it is noted that in 1967, Streich's patent year, the mediums are paper related. However, in May, 1999, Applicant' priority month, it is obvious that Streich's wide range of mediums can also be automated and be an electronic medium like a CD. One would be motivated to do this to better be able to provide information of interest. As a further example of this, Blohm discloses a CD-ROM attached to an article of merchandise (Figs. 7, 12) and that the CD-ROM can perform an advertising function (1:52-60; 1:27-60). Also, note in Blohm that the CD-ROM is operably independent from and the advertising information is substantively distinct from the product (Figs. 7, 12; 1:52-60). Note in Blohm that the article of merchandise or magazine can be any magazine aimed at the wealthy (Better Homes and Gardens, Cigar Aficionado, Travel and Leisure, Money magazine are examples of magazine that can be aimed at wealthier individuals) while the CD-ROM advertising canbe for luxury automobiles (BMW, Rolls Royce, Merceded, etc). Hence, the CD-ROM advertising is substantively distinct from the product/merchandise/magazine. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Blohm’s CD-ROM as ad medium to Streich's wide range of ad medium and messages. One would have been motivated to do this in order to better provide ad information of interest. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely

would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 110. The prior art further discloses the article of claim 107, wherein the computer readable medium stores a presentation to the user independent from the product (Blohm, 1:45-60).

Claim 111, 118, 131. The prior art further discloses the article of claim 107, further comprising packaging covering at least a portion of the product, the label being selectively secured to the packaging (Streich, 1:10-20; 5:45-60).

Claim 112. The prior art further discloses the article of claim 111, wherein the label is contained within the packaging to be retained therein (Blohm, Figs 7, 12).

Claim 113. The prior art further discloses the article of claim 112, wherein the label is secured to the exterior of the packaging (Streich, 1:10-20; 5:45-60).

Claim 115. Streich does not explicitly disclose providing instructions for installing the label in a drive associated with the computer of the purchaser. However, Blohm discloses providing a CD (Figs. 7, 12). Hence, it is obvious that he CD can include standard instructions like “insert CD into drive”. One would be motivated to do this so the user can better operate the CD. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 116. The prior art further discloses the method of claim 114, wherein the vendor data further comprises executables effective to program the computer of the purchaser (1:45-60). Examiner notes that, without further distinction in the claim, the CD-ROM running on the user computer to show luxury automobile advertising functions executables programming the computer of the purchaser to, in this case, run the presentation.

Claim 117. The prior art further discloses the method of claim 114, wherein the vendor data comprises instructions effective to present to the purchaser additional advertising impressions from the computer of the purchaser (Blohm 1:45-60).

Claim 119. The prior art further discloses the method of claim 118, wherein the packaging connects the label to the product (Streich, 1:10-20; 5:45-60).

Claim 120. The prior art further discloses the method of claim 119, further comprising providing a pedestal positioning the label with respect to the packaging (Blohm Figs. 7, 10, note in these Figures that the sleeve functions as a pedestal by holding the CD up with respect to the packaging).

Claim 121, 132. The prior art further discloses the method of claim 118, wherein the packaging completely encloses the product (Streich Fig. 3; Blohm 3:20-40).

Claim 122. The prior art further discloses the method of claim 118, wherein the label is attached to at least one of the product and the packaging in a manner so as to be readily removable by the purchaser without damage to the product and without damage to the label (Streich 1:10-20; 5:45-60).

Claim 123. The prior art further discloses the method of claim 118, further comprising fixing the label directly to at least one of the product and the packaging (Streich 1:10-20; 5:45-60).

Claim 125. The prior art further discloses the method of claim 124, wherein the advertising impression corresponds to at least one of the product, a manufacturer thereof, and the source (Streich, 5:45-60; Blohm, 1:45-60).

Claim 126. The prior art further discloses the method of claim 124, wherein the presentation comprises entertainment presenting additional advertising impressions corresponding to at least one of the product, the manufacturer, and the source (Streich 5:45-60).

Claim 127. The prior art further discloses the method of claim 124, wherein the presentation is an audio-visual presentation by the first computer (Blohm 1:45-60).

Claim 128. The prior art further discloses the method of claim 124, wherein the presentation is entertainment selected from a game, a movie, an advertisement, and a test (Streich 5:45-60).

Claim 130, 138. The prior art further discloses the article of claim 129, wherein the computer readable storage medium comprises a physical object having a face presenting the advertising impression;
wherein the computer readable storage medium is at least one of optically, magnetically, and electronically readable (Blohm Figs. 7, 10; 1:27-60).

Claim 133. The prior art further discloses the article of claim 131, wherein the packaging comprises plastic selected from soft plastic and hard plastic (Blohm 3:20-40).

Claim 134. The prior art further discloses the article of claim 132, wherein the packaging further comprises a detent fixing the label to the packaging (Blohm Figs. 7, 10).

Claim 135. The prior art further discloses the article of claim 132, wherein the label is completely inside the packaging (Blohm Figs. 7, 10).

Claim 137. The prior art further discloses the apparatus of claim 136, wherein the apparatus further comprises at least one of:
a protector, covering the computer readable storage medium before use; and
the label monolithically integrated with the computer readable storage medium (Blohm Figs. 7, 10).

Claim 139. The prior art further discloses the apparatus of claim 136, wherein the computer readable storage medium is formatted in at least one of a compact disk, floppy disk, digital video disk, magnetic strip, bar code, symbolic code, and an embedded chip (Blohm 4:10-25).

Claim 140. The prior art further discloses the apparatus of claim 136, further comprising: the first information printed on the label communicating to the user an identification of at least one of the product and the source by at least one of a color, shape, symbol, word, name, and phrase; the computer readable storage medium further containing second information comprising information about at least one of the product, the source, other products, use of the product, services corresponding to the product, a game, entertainment, music, a data gathering interface, a test, a browser, a launcher, and an internet link; and the computer readable storage medium, readable by at least

one of an electromagnetic, optical, and electronic reader (Blohm Figs. 7, 10; Blohm 1:27-60; Blohm 5:30-55; Streich 5:45-60;).

Claim 142. The prior art further discloses the method of claim 141, wherein the product is selected from a magazine, a garment, headgear, footwear, a toy, a foodstuff, furniture, an appliance, sporting goods, dry goods, a tool, and a plant (Blohm 1:27-60).

Claim 143. The prior art further discloses the method of claim 141, wherein: the product is secured to at least one of a protector covering the computer readable storage medium before use, and the label monolithically integrated with the computer readable storage medium; the computer readable storage medium is readable by at least one of an electromagnetic, optical, and electronic reader; and
the computer-readable storage medium is formatted in at least one of a compact disk, floppy disk, digital video disk, magnetic strip, bar code, symbolic code, and an embedded chip (Blohm 1:27-60; Figs 7, 10).

Claims 106, 108, 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Streich (3,314,592) in view of Blohm (5,881,538) in further view of Mages (6463467)

Claim 106, 108, 109. Streich does not explicitly disclose wherein the computer readable medium further contains executable instructions effective to direct the first processor to obtain additional data over the network. However, Mages discloses wherein the computer readable medium further contains executable instructions effective to direct the first processor to obtain additional data over the network (Figs. 5-

7; 6:45-7:30). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Mages CD-ROM with links to the prior arts medium and CD with information. One would have been motivated to do this in order to better provide information of interest. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

Examiner notes the Interview on 1/20/11. Please see the Interview Summary. Also, the IDS dated 1/6/11 was reviewed. Also, the Examination above is for the 1/20/11 copy of the claims. And, Examiner notes that all new claims were submitted on 1/4/11 and then, after the interview on 1/20/11, further amended claims of the new claims were submitted on 1/20/11.

Examiner notes that on 12/31/2009 the BPAI fully affirmed the prior rejection of the claims in this case. Hence, the BPAI decision and all the prior rejections are affirmed and are now part of the record on this case.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Lanpher et al (5,333,106) discloses a method and apparatus for attaching a

data storage device to a product which contains computer readable instructions to enable the user to learn and monitor the correct usage of an aerosol pharmaceutical product.

b. Grundy (5,375,240) discloses a method and apparatus for distributing information on a machine readable medium which includes executable instructions for registering the software on the machine readable medium.

c. Redford et al(5,711,672) discloses a method and apparatus for automatically starting the execution of computer readable instructions stored on a storage media which automatically copies a new version of the software into the storage media.

d. Tycksen, Jr. et al (5,898,777) discloses a method and apparatus for disseminating digital products storing a plurality of software programs as packages.

e. Ronning (5,907,617) discloses a method and apparatus for distributing software on a storage media which also contains executable instructions for tracking and reporting the number of times the software was used.

f. Takahashi et al (6,195,432) discloses a method and apparatus for distributing software on a storage media which contains executable instructions for downloading updated and full versions of the software.

g. Fuller et al (6,216,112) discloses a method and apparatus for distributing software on a storage media which also including executable instructions for retrieving and presenting advertisements to the user.

h. Collart (6,405,203) discloses a method and apparatus for preventing unauthorized use of the contents on a storage media by executing stored instructions to retrieve authorization (and codes) from a remote device.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2/10/2011